

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

United States Patent No. 5,784,808

Issued: 28 July 1998

Inventor: Stan Hockerson, a U.S. citizen, of Albuquerque, NM

Assignee: HOCKERSON-HALBERSTADT, INC. (a Louisiana corporation)

FOR: "Independent impact suspension athletic shoe"

ATTORNEY DOCKET NO.: A09027US (99413.1)

Declaration of Stan Hockerson

I am the inventor and the president of the assignee of the above-referenced patent.

I received a reminder (copy attached as Exhibit A) about payment of the 4-year maintenance fee from Richard Backus. I authorized payment of the 4-year maintenance fee through Richard Backus by sending him my check no. 3219 dated 12 January 2002 (copy attached as Exhibit B). I understand that the 4-year maintenance fee was paid by Richard Backus.

John P. "Johnny" Halberstadt and I have been partners in business since around 1991, when we formed Hockerson-Halberstadt, Inc. We together have seven issued patents (some in my name, some in Johnny's name, and some assigned to Hockerson-Halberstadt, Inc., as detailed in the table set out below). We have always paid the maintenance fees in these patents. Since around 1978, Richard Backus has handled my patent work, and since around 1991 Richard Backus has handled our patent work. Richard Backus has always timely sent us reminders of the maintenance fees due (except for the second maintenance fee due in United States Patent No. 5,784,808). We have issued over 70 licenses of our patent rights, and we have received millions

of dollars licensing our patent rights. We would never knowingly allow one of our patents to lapse for failure to pay a maintenance fee.

Hockerson-Halberstadt, Inc. (the assignee of United States Patent No. 5,784,808), Johnny Halberstadt, and I treated this patent, and all of our patents, as a reasonable and prudent person would treat his or her most important business. The patents are in fact our most important business. All of HHI's income is from patent royalties, and in many years I have made more money in patent royalty income than from my other business ventures (I own a retail shoe store in Albuquerque, NM).

I understood that Richard Backus would send us a reminder regarding future maintenance fees, as Richard Backus has represented me in patent matters since around 1978 (he has handled patents, a reexamination proceeding, and an appeal in the Court of Appeals for the Federal Circuit related to Hockerson-Halberstadt, Inc. patents). He has obtained several patents for me and Johnny Halberstadt, and he has handled the maintenance fees for me, Johnny Halberstadt, and Hockerson-Halberstadt, Inc. In the over 30 years since Richard Backus first represented me, he has always timely informed me or reminded me of deadlines, except for renewal reminders in relation to the 8-year maintenance fee of United States Patent No. 5,784,808 (and, as I have recently learned, an annuity due in a European patent application of HHI, where it appears that Mr. Backus did not receive copies of correspondence from British patent counsel regarding the annuity). That annuity has now been paid and the payment has been accepted.

Unfortunately, I never received any renewal reminders in relation to the 8-year

maintenance fee from Richard Backus.

I have since learned (on or about 18 November 2008, when I received an answer to a complaint in a lawsuit filed by Hockerson-Halberstadt, Inc. and Standon LLC against New Balance Athletic Shoe, Inc. asserting infringement of United States Patent No. 5,784,808) that the above-referenced patent lapsed on 28 July 2006 for failure to pay the 8-year maintenance fee.

Patent attorneys have been engaged on behalf of me and Hockerson-Halberstadt, Inc. to investigate what happened and whether the patent could be revived. After much investigation (including searching of my patent files from on or about 18 December 2008 through 6 January 2009, and obtaining on or about 8 January 2009 a copy of a check used to pay Richard Backus for the first maintenance fee) it appears that the reason I did not receive a renewal reminder is that there was a docketing error which caused reminders about United States Patent No. 5,784,808 to be removed from Richard Backus's docket system, apparently sometime after the payment of the first maintenance fee in that patent.

I did not deliberately allow United States Patent No. 5,784,808 to lapse. The lapsing of United States Patent No. 5,784,808 was unintentional and unavoidable. I understood that Richard Backus, who I had engaged to handle my patent matters and as of 28 July 2006 had represented me for about 30 years in patent matters, would timely remind me of due dates for the 8-year and 12-year maintenance fees in United States Patent No. 5,784,808, as he had for the 4-year maintenance fee.

I did not deliberately delay in paying the 8-year maintenance fee. Since I learned of the

failure to timely pay the fee, I have worked to determine whether the fee could be paid late and what steps must be taken to pay the fee late. I would like for the 8-year maintenance fee to be accepted at this time.

HHI and I relied on our patent attorney, a competent professional who for 30 years had timely reminded me of deadlines. We had no reason to believe that there was anything amiss about my patent and thus had no reason to inquire into whether the second maintenance fee was paid - Richard Backus had already timely reminded us about and timely paid over 10 maintenance fees in many patents. I had no reason to believe that he would not do so for all of our maintenance fees.

Once we realized that the second maintenance fee was not paid, and that the exact circumstances of why the fee was not paid were unclear, we transferred responsibility of docketing of my maintenance fees to another patent attorney.

It is respectfully submitted that HHI and I had no reason to make inquiry into the status of the patent. It is respectfully submitted that we had no reason to question Mr. Backus's docketing abilities, as for 30 years he had timely notified us of deadlines while handling our patent matters, and never before this has a deadline been missed. In particular, Mr. Backus was the patent attorney who obtained US Patent No. 4,322,895 for me, and maintained the patent until it expired in 1999 at the end of its 20 year from filing term. In about 1991 Mr. Backus took over maintenance of US Patent No. 4,259,792 when it was assigned to HHI, and maintained the patent until it expired in 1999 at the end of its 20 year from filing term. HHI and I had no more reason

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to check to see if our patents were properly maintained than we would to check to make sure that our CPA actually prepared proper tax returns. We hired competent professionals to conduct these tasks for us, and before this unfortunate failure to pay a maintenance fee, did not even know how to inquire into the status of a patent (other than by asking Richard Backus, our patent attorney).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent.

4-27-09

Date

Stan Hockerson

Stan Hockerson
6718 Mossman Place North East
Albuquerque, NM 87110
Tel.: 505 875 1947

Patents of Stan Hockerson and Johan Halberstadt (with current status):

GSNN Ref. No. Application No. Filing Date Inventor (Assignee of record)	Patent No. Issue Date Expiration Date	Title Publication No.	Maintenance fees/ due
99413.5 10/909,972 3 August 2004 Stan Hockerson	7,111,415 26 September 2006 17 February 2024	Athletic shoe frame US 2005/0198863	26 March 2010, 2014, 2018 CIP of 10/714,546, filed 14 November 2003 Term ext by 93 days
99413.4 09/402,746 12 October 1999 Stan Hockerson, Thomas C. Lynch	6,273,827 14 August 2001 12 October 2021	Golf putter head	14 Feb. 2005 (paid 14 Feb. 2005), 2009 (paid 13 Feb. 2009), 2013
99413.3 09/308,050 11 May 1999 Stan Hockerson	6,145,221 14 November 2000 11 May 2019	Cleated athletic shoe	14 May 2004 (paid 14 Jan 2004), 2008 (paid 12 Dec 2007), 2012

99413.1 08/714,964 17 September 1996 Stan Hockerson (Hockerson- Halberstadt, Inc.)	5,784,808 28 July 1998 1 March 2013	Independent impact suspension athletic shoe	(currently lapsed - working on reviving) 28 January 2002 (paid 18 Jan 2002), 2006 (not paid), 2010 fee was due 28 July 2006 with 6 month grace period - next due 28 January 2010 Cont of 400,336, filed 8 March 1995; which is a CIP of 259,744, filed 14 June 1994; which is a Cont of 24,601, filed 1 March 1993
99413.2 08/524,726 6 September 1995 Johan Halberstadt	5,678,327 21 October 1997 21 July 2014	Shoe with gait- adapting cushioning mechanism	All Mfees paid 21 April 2001 (paid 16 May 2001), 2005 (paid 7 April 2005), 2009 (paid 16 Feb. 2009) CIP of 260,718, filed 21 July 1994
99413.1 06/101,708 10 December 1979 Stan Hockerson (Hockerson- Halberstadt, Inc.)	4,322,895 6 April 1982 10 December 1999	Stabilized athletic shoe	expired (all Mfees paid)

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99413.1 06/061,427 27 July 1979 Johan Halberstadt (Hockerson- Halberstadt, Inc.)	4,259,792 7 April 1981 27 July 1999	Article of outer footwear	expired (all Mfees paid)
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Exhibit A - Hockerson Declaration

LAW OFFICES OF RICHARD E. BACKUS

Richard E. Backus
Kristin Hansen, Of Counsel

Patent, Trademark and Copyright Law
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Jan 3, 2002

Stan Hockerson
6718 Mossman Place, N.E.
Albuquerque, NM 87110

Re: Independent Impact Suspension Athletic Shoe
Patent #5,784,808
A-59987-3

Dear Stan:

This patent has come up on our docket to remind you that the first maintenance fee must be paid by the due date of Jan 28, 2002, or the patent will lapse.

This patent issued under the "small entity" fee status on the basis that you had less than 500 employees, and that there was no other entity having more than 500 employees which had a license or other rights under the patent. If the status has changed such that any of your licensees have more than 500 employees, then we are obligated to advise the Patent Office for purposes of calculating the maintenance fee. Assuming that the small entity status of this patent is still appropriate then the costs and services for paying the maintenance fee will be \$1,030 (\$880 PTO fee plus our \$150 service fee).

Please advise if you wish us to pay the maintenance fee. If we do not hear from you by the due date we will take no further action in this matter and the patent will lapse. Because of the size of the PTO fee, we will require advance payment of the total to pay the maintenance fee on your behalf.

Very truly yours,



Richard E. Backus

Exhibit B - Hockerson Declaration

STAN HOCKERSON 02/01 6716 MOSSMAN PL. NE 505-875-1947 ALBUQUERQUE, NM 87110		95-648/1070 0100005510	3219
PAY TO THE ORDER OF <u>Richard Bachus</u>		DATE <u>1-12-02</u>	\$ <u>1,030⁰⁰</u>
<u>one thousand thirty dollars 00/100</u>		DOLLARS	
The Bankers Professional Bank 2000 Louisiana Blvd. NE • (505) 879-1500 Albuquerque, NM 87110			
MEMO <u>Patent re-issue renewal</u>			

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